

REMARKS

I. Status of the Claims

Claims 18, 20-28, and 30-51 are pending in this application.

II. Rejection Under 35 U.S.C. § 103

In the Final Office Action¹ dated October 29, 2007, the Examiner maintained the rejection of claims 18, 20-28, and 30-51 under 35 U.S.C. § 103(a) as unpatentable over Mitsumatsu et al., WO 99/13830 ("Mitsumatsu") in view of Oshima, JP 401009916A ("Oshima") and Sebag et al., WO 98/03155 (also U.S. Patent No. 6,162,423) ("Sebag"). See Final Office Action at 2.

In the Final Office Action, the Examiner alleges that

"the combination [of Mitsumatsu and Oshima] is still obvious ... because the weight amounts of stearyl and behenyl alcohols of the two similar prior arts are within obvious ranges, and particularly because Oshima teaches using the two compounds with specific weight amount and ratio with the specific cosmetic advantages thereof. A skilled artisan still would have had a sufficient motivation to modify the teachings of ... Mitsumatsu by using the amount of the fatty alcohols as taught by Oshima in expectation of enhancing the cosmetic properties and stability of the shampoo."

See Final Office Action at 2-3. In addition, the Examiner alleges that

"Mitsumatsu already teaches in general that stearyl and behenyl alcohols can be used in a mixture, [and] Oshima provides a specific ratio and weight range that can be used as a mixture, which would have supplied motivation to ... make the claimed invention with an expectation of successfully producing a stable composition"

See Final Office Action at 3.

¹ The Office Action may contain a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Applicants respectfully disagree and submit that the Examiner has not provided any rationale as to why the combination of Mitsumatsu and Oshima would be obvious, as alleged. Instead, the Examiner's statement that "weight amounts of stearyl and behenyl alcohols of the two similar prior arts are within obvious ranges" is incorrect and conclusory. As required by the Supreme Court, and as highlighted in M.P.E.P. § 2142, such rationale must be clearly set forth by the Examiner in order to support a rejection under 35 U.S.C. § 103. See *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007)("[t]o facilitate review, this analysis [of whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue] should be made explicit.")

Applicants established in their Response Under 37 C.F.R. § 1.111, filed May 16, 2007, that Mitsumatsu does not disclose or suggest either of:

1. weight amounts of either stearyl alcohol or behenyl alcohol that are within the range claimed by Applicants; or
2. stearyl alcohol and behenyl alcohol present in a ratio within the range claimed by Applicants.

Instead, Mitsumatsu only discloses weight amounts for stearyl alcohol and behenyl alcohol in Examples 3, 4, and 5 of Mitsumatsu, and in those Examples, stearyl and behenyl alcohols are not present together in the same composition. Further, Mitsumatsu discloses weight amounts of 0.1 wt % for behenyl alcohol in Example 3 and 0.1 wt % and 0.2 wt % for stearyl alcohol in Examples 4 and 5 respectively. These values are outside the ranges claimed by Applicants.

The Examiner attempts to overcome the deficiencies of Mitsumatsu by applying Oshima. However, as also established in Applicants' May 16, 2007 Response, Oshima gives weight percentage ranges for stearyl and behenyl alcohol of 0.5-5 wt % and

0.75-7.5 wt % respectively, which do not overlap with the weight percentages given by Mitsumatsu for behenyl alcohol in Example 3 or for stearyl alcohol in Examples 4 and 5.

Therefore the weight amounts of stearyl and behenyl alcohols, as disclosed in Mitsumatsu and Oshima are not within obvious ranges, as alleged by the Examiner (Final Office Action at 2). Rather, the weight amounts disclosed in Mitsumatsu and Oshima are very different, and as a result, they do not suggest or render obvious any particular range(s) of weight amounts. Thus, it would not be obvious to combine the disclosures of Mitsumatsu and Oshima regarding weight amounts of stearyl and behenyl alcohols in order to achieve Applicants' claimed invention.

As to the Examiner's allegation that "Oshima teaches using the two compounds ... with the specific cosmetic advantages thereof" (*Id.* at 2-3), Applicants submit that Oshima teaches "a shampoo composition containing a specific amount of a specific amphoteric surfactant, polypeptide, stearyl alcohol and behenyl alcohol as essential components" (English translation of Oshima, p. 3). The properties and "cosmetic advantages thereof" disclosed by Oshima appear to be due to the combination of the four components that Oshima labels essential, and not due solely to stearyl alcohol and behenyl alcohol, or the weight amounts or ratio of stearyl alcohol and behenyl alcohol. For example, Oshima discloses that one objective is to achieve "a shampoo composition [with] pearl luster whose appearance is glossy." *Id.* Oshima also discloses that "[a]lthough the reason why the pearl luster is added to the shampoo composition of the present invention is not clear, it is assumed that this is because complex salt of ... amphoteric surfactant, a specific compounding ratio of stearyl alcohol to behenyl alcohol and polypeptide is precipitated" (English translation of Oshima at 8). Thus,

Oshima attributes the pearl luster of its composition to an interaction among the four essential components of Oshima. These four essential components of Oshima are not merely "additional" components that could be added to a shampoo composition. Rather, Oshima appears to suggest that a shampoo composition without all four of the essential components would not possess a pearl luster effect.

Therefore, the mere allegation that "Mitsumatsu ... teaches ... that stearyl and behenyl alcohols can be used in a mixture," combined with the "specific ratio and weight range" of Oshima (Final Office Action at 3), does not provide motivation to combine the teachings of Mitsumatsu and Oshima. Since Oshima requires four essential components, the presence of only stearyl and behenyl alcohols is not sufficient to satisfy the requirements of Oshima. Further, as noted, Mitsumatsu does not disclose any examples of stearyl alcohol and behenyl alcohol in combination, and the weight amounts of stearyl alcohol and behenyl alcohol disclosed in Mitsumatsu and Oshima do not overlap.

Thus, contrary to the Examiner's allegations, the combination of Mitsumatsu and Oshima is not obvious, and there is no reason to combine the teachings of Mitsumatsu and Oshima in an attempt to arrive at Applicants' claimed invention.

The Examiner also alleges that

"the scope of the claimed composition is open to include other ingredients not recited in the instant claims, such as the other ingredients of Oshima ... that might render the advantageous properties to improve the Mitsumatsu invention" and "the skilled artisan would have had a reasonable expectation of success ... [in] modifying the Mitsumatsu product by adding the ingredients of the Oshima reference"

See Final Office Action at 3.

However, Applicants submit that merely combining “the other ingredients of Oshima” to the invention of Mitsumatsu, as proposed by the Examiner, would not render obvious Applicants’ claimed invention. See *Id.*

Mitsumatsu discloses “shampoo compositions comprising: (a) an effective amount of a triazole; (b) a deterative surfactant; and (c) a carrier.” See Mitsumatsu, Abstract. Mitsumatsu discloses the use of triazoles as optical brighteners in shampoo compositions, and teaches that “[s]hampoo compositions typically include an anionic deterative surfactant for good cleansing” and “[t]hese anionic deterative surfactants may interfere with the deposition of optical brighteners.” See *Id.* at 2, lines 4-6. Mitsumatsu further teaches that “triazoles have a slight positive charge” and “have good compatibility with . . . anionic deterative surfactants” (*Id.* at page 2, line 34 and page 3, lines 3-4). Further, Mitsumatsu teaches “triazoles are believed to have good deposition on the surface of the hair, as hair is slightly negatively charged.... Thus, shampoo compositions comprising triazoles can provide good deposition to the hair in combination with a wide variety of deterative surfactants.” See *Id.* at page 4, lines 8-11.

Therefore, triazoles appear to be a required component of the shampoo composition of Mitsumatsu for both optical brightening and deposition on hair. As such, the triazoles of Mitsumatsu, like the “essential” components of Oshima, are not merely “additional” components that could be added to a shampoo composition. Rather, Mitsumatsu suggests that a shampoo composition without triazoles would not achieve the desired optical brightness and/or deposition on hair.

Regarding the “other ingredients of Oshima” (Final Office Action at 3), and as noted above, Oshima discloses “a shampoo composition containing a specific amount

of a specific amphoteric surfactant, polypeptide, stearyl alcohol and behenyl alcohol as essential components" (English translation of Oshima, p. 3).

The combination of Mitsumatsu and Oshima, proposed by the Examiner, would be limited by the requirements disclosed by each of Mitsumatsu and Oshima -- namely that the composition must contain triazoles to achieve the optical brightening required by Mitsumatsu, and the composition must contain the four essential components of Oshima (a specific amphoteric surfactant, polypeptide, stearyl alcohol, and behenyl alcohol). It is not known whether such a composition, based on the combination of Mitsumatsu and Oshima, would actually satisfy the requirements of either Mitsumatsu or Oshima. Thus, there is not a reasonable expectation for success in combining Mitsumatsu and Oshima. Moreover, the combined teachings of Mitsumatsu and Oshima would still not disclose or suggest the use of stearyl alcohol and behenyl alcohol in the weight amounts claimed by Applicants. Thus, there is also not a reasonable expectation that combining the teachings of Mitsumatsu and Oshima would successfully achieve Applicants' claimed invention.

The Examiner also cites Sebag and alleges that

"the present rejection is based on the notion that **incorporating** an opacifier/pearlescent component into the Mitsumatsu product or the combined composition of Mitsumatsu/Oshima would have been obvious. The skilled artisan would have had a reasonable expectation of successfully producing an improved shampoo composition with the combined cosmetic effects of triazole optical brightener of Mitsumatsu and the pearlescent effect of the dialkyl ether of Sebag."

See Final Office Action at 4, emphasis in original.

Sebag is cited by the Examiner with regard to the use of dialkylether. Applicants established in their Response Under 37 C.F.R. § 1.111, filed May 16, 2007, as well as

in their Pre-Appeal Brief Request for Review, filed September 15, 2006, and their Amendment, filed February 10, 2006, that Sebag does not suggest that dialkylether is responsible for the pearlescent effect. Moreover, Sebag makes no attribution for the pearlescent effect.

Nevertheless, with regard to opacifying or pearlescence, Applicants submit that Mitsumatsu does not require or suggest any benefit from including an opacifier/pearlescent component in the composition of Mitsumatsu. Merely adding an opacifier/pearlescent component to Mitsumatsu would not provide any expectation of producing Applicants' claimed invention, at least because Mitsumatsu does not disclose or suggest the use of stearyl alcohol and behenyl alcohol in the weight amounts and ranges claimed by Applicants.

As discussed above, Oshima attributes its pearl luster to an interaction among the four essential components of Oshima. See English translation of Oshima at 8. Also as noted, Oshima suggests that a shampoo without all four of the essential components would not possess a pearl luster effect. As also noted above, there is no reasonable expectation that the mere combination of Mitsumatsu and Oshima would satisfy the requirements of each of Mitsumatsu and Oshima, or that such a combination would achieve Applicants' invention.

Moreover, even if the dialkylether of Sebag was added to the combination of Mitsumatsu and Oshima, the teachings of Sebag do not overcome the above-noted deficiencies of either Mitsumatsu or Oshima. Thus, a composition based on the combination of Mitsumatsu, Oshima, and Sebag would still have to meet the requirements of each of Mitsumatsu and Oshima. However, there is no reasonable

expectation that such a combination would actually satisfy the requirements of either Mitsumatsu or Oshima.

Thus, for at least the above-noted reasons, the combination of Mitsumatsu, Oshima, and Sebag do not render obvious Applicants' claimed invention, as described in independent claims 18, 47, 49 and 50. Independent claims 18, 47, 49 and 50 should therefore be allowable under 35 U.S.C. § 103(a) over each of Mitsumatsu, Oshima, and Sebag. Claims 20-28 and 30-51 should also be allowable at least due to their respective dependence on base claim 18, 47, 49 or 50.

Applicants therefore request that the rejection of claims 18, 20-28, and 30-51 be withdrawn.

III. Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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